

Application No.: 10/719,164
Response dated: April 17, 2006
Reply to Office Action of 10/19/2005

Amendments to the Drawings:

Please substitute drawing Figures 1-3 attached herewith for drawing Figures 1-3 as filed with the application.

REMARKS

By an Office Action dated October 19, 2005 in the file of the above-identified application, the Examiner rejected the application on a variety of grounds. Based on this response, reconsideration of the merits of this patent application is respectfully requested.

First, the Examiner requested that new corrected drawings be filed. The objection to the prior drawings was because the photographs were mounted on paper. Attached herewith are photographs developed on paper which meet the full size and margin requirement of 37 C.F.R. 1.84. Each figure is printed or developed on a single sheet, and duplicate of each of the figures are enclosed. The figure are labeled replacement page, as required by the Patent and Trademark Office rules. It is believed that this submission will cure this deficiency in the application.

The claim was rejected under 35 U.S.C. 102 as failing to patentably distinguish over Huxley et al. The Examiner states that no patentable distinction was found between the description of the claimed plant in the present specification and the description of the species *Alnus maritima* in Huxley et al. The applicants respectfully strenuously disagree.

Huxley et al. contains a general description of the species *Alnus maritima*. The specification of this application recites that a trial of a number of sexually produced seaside alder plants was conducted from seedlings, and the seedlings were all grown out on the campus of Iowa State University (paragraph 22). The seeds were cultivated into mature plants that were scored and evaluated. The highest scored plant was then selected for asexual propagation.

The specification then goes on to recite that the characteristics of the asexually reproduced plant, now known as "September Sun," are statistically different from the other *Alnus maritima* plants from that same trial and other *Alnus maritima* cultivars. The "September Sun" seaside alder generates more leaves and auxiliary shoots than other plants of this species and generates leaves which become mottled blends of yellow, orange, and rich brown under autumnal conditions (paragraph 23). Set forth in paragraph 24 of the specification is a set of clear statistical differences related to the rate of growth of the plant, the density of foliation, and the volume of canopy of September Sun compared to other plants of the species. These side-by-side comparisons between the cultivar September Sun and other cultivars of the species demonstrates clear statistical significance in terms of rate of growth, canopy height, and canopy volume compared to other plants of the species.

Application No.: 10/719,164
Response dated: April 17, 2006
Reply to Office Action of 10/19/2005

It is submitted by the applicants here that this statistical information establishes that the cultivar September Sun differs from other genotypes of the species in its rate growth, in the density of its foliation, and its canopy height, and in its canopy volume. Thus this cultivar is different from the other plants of the species. That difference is submitted by the applicants to be sufficient to be patentably distinct from the species as a whole, as exemplified by the Huxley et al. paper.

Next the Examiner objects to the specification on the grounds that the specification presents less than a full, clear and complete botanical description of the plant. The applicants here have set forth the characteristics which distinguish the plant from others of its species. There is a clear and concise set of distinctions which distinguish this plant from others of the species, notably rate of growth, density of foliation, and autumnal colors which distinguish this plant from others of the common species. The applicants have provided a color dictionary reference for the foliation and the flowering as well as the fruiting structure. The colors of the male and female inflorescence are referenced by specific colors from a color dictionary.

The Examiner then cites to page 3, lines 5-12 of the specification where the applicants appear to describe the species in general rather than the claimed plant. With regard to these specific traits and descriptions in this passage, the descriptions are both of the claimed plant and of the species in general. None of these descriptions are intended to be distinctive of this variety of plant from the species or subspecies in general. The distinction between the cultivar sought to be patented here and the species in general is contained largely in paragraph 24 related to rate of growth and dense foliation. The general descriptions in this particular portion of the specification are generic to the species, and are not unique in the cultivation sought to be patented here. This information was included in the interest of completeness.

Next the Examiner objected to the claim as not being supported by a clear botanical description of the plant. The applicants believe that this grounds for rejection is also poorly supported and should be reconsidered.

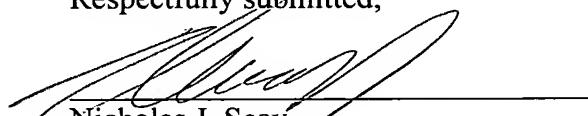
Note that the applicants have amended the claim so as to specifically recite the distinguishing features of the plant. The difference between what the Examiner has asked, and what the applicants have not provided here, are descriptions of the species as a whole which would not add to the descriptive attributes of the patent on this particular cultivar. The

Application No.: 10/719,164
Response dated: April 17, 2006
Reply to Office Action of 10/19/2005

differences between this cultivar and the species as a whole are clearly recited in the specification, and have also now been recited in the claim. Accordingly, it is believed that the specification of this patent application is sufficient to describe the cultivar sought to be patented here and to distinguish it from other plants of its species. Furthermore it is believed that the specification and claims supported by it are definite within the meaning of Section 112 as applied to plant patent applications filed under 35 U.S.C. 161. Accordingly, reconsideration of the merits of this patent application is respectfully requested.

A separate Petition for Extension of Time is submitted herewith so that this response will be considered as timely filed.

Respectfully submitted,



Nicholas J. Seay
Reg. No.: 27,386
Attorney for Applicants
QUARLES & BRADY LLP
P.O. Box 2113
Madison, WI 53701

TEL 608/251-5000
FAX 608/251-9166